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HEWLETT-PACKARD COMPANY
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EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
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2626

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,649

Applicant(s)

PARRY, TRAVIS J.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **12/29/04**.
2. This application has been reconsidered. Claims 1-19 are pending.

Double Patenting

3. Claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 09/925,650. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Receiving data at a printer; detecting a network address in the received data; requesting authorization to access the network (claims 10, 11, 12, 13 and 14 of Application 09/925,650); sending on the Internet or other network an access request for a document to the network address; retrieving the document from the network address and printing the document.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

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application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 13, 14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata (U. S. 6,537,324) in view of Russell et al (Russell) (U. S. 6,375,078).

With respect to claims 1, 6, and 19, Tabata discloses a printing method comprising receiving print stream data (which reads on image data from medium form 420) at a printer (470B) (column 23, lines 56-63); detecting at the printer (which reads on the copier, 470, figure 20) if a network address is in the received print stream data (column 23, line 56 to column 24, line 17 and column 27, lines 9-33); sending on the Internet an access request for a document to the network address from the printer (copier) (column 24, lines 18-23); retrieving the document at the printer (copier) (column 24, lines 24-25), merging at the printer (copier) the document from the network address into the print data stream to form a modified document (column 30, line 46 to column 31, line 19 and column 24, lines 24-49) (the correlated information file is incorporated with the medium form information to form a single document), and printing the modified document (column 24, lines 36-38).

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Tabata differs from claims 1, 6, and 19 in that he does not clearly disclose requesting from the printer (copier 470) authorization from a user entity to access the network address. Russell discloses a method for retrieving information from a network source wherein authorization for access to the network occurs by requiring the user to enter an access code (column 19, line 55 to column 20, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata wherein a user name or password is sent to the remote administration location. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Russell in order to improve the security of the system.

With respect to claim 2, Tabata discloses the address is a URL (column 12, lines 43-47).

With regard to claims 3, 13, and 14, Tabata discloses detecting a barcode (column 6, lines 26-37).

With regard to claims 4 and 5, Tabata discloses printing the untranslated barcode (column 26, lines 32-46).

With respect to claims 7, 8, 9, and 10, Tabata differs from claims 7, 8, 9, and 10 in that he does not clearly disclose sending authorization based on a criteria. Russell discloses restricting use of the network based on certain security functions (column 19, line 55 to column 16, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata to send authorization based on a criteria. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Russell in order to improve the security of the system.

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With regard to claim 18, Russell discloses providing web content to a user location to display a menu of authorization selections (column 19, line 62 to column 20, line 6).

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Russell as applied to claim 1 above, and further in view of Wolff (U. S. 5,848,413).

With respect to claims 11 and 12, Tabata as modified differs from claims 11 and 12 in that he does not clearly disclose receiving E-mail containing the data. Wolff discloses a method for retrieving data from the Internet wherein the data is retrieved via E-mail (column 10, lines 37-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata as modified wherein the data is received by E-mail. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata as modified by the teaching of Wolff in order to allow for simplified access to the Internet.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Russell as applied to claim 1 above, and further in view of Wolff.

With respect to claims 15, 16, and 17, Tabata as modified differs from claims 15, 16, and 17 in that he does not clearly disclose printing the document within another document and

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identifying the contents of the documents. Wolff discloses printing the document within another document and identifying the contents of the documents (column 6, lines 29-37 and lines 58-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata as modified to print the document within another document and identify the contents of the documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata as modified by the teaching of Wolff in order to allow greater user control of the formatting of the retrieved documents.

Response to Arguments

9. Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive.

Applicant's response with regard to the Double Patenting rejection is hereby noted. However, the Examiner will maintain this rejection until the final form of the claims is determined.

Applicant continues to argue that although *Tabata* teaches that the scanner and printer units may be integrated into a single device – a copying machine, one of ordinary skill in the art would not arrive at the notion that the printer can be expected to perform some or all of the functions of the scanner and vice versa, and that *Tabata* teaches away from the claimed invention.

The Examiner is confused by the first argument (that one of ordinary skill in the art would not arrive at the notion that the printer can be expected to perform some or all of the

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functions of the scanner and vice versa). The Examiner has never submitted that the printer performs functions of the scanner.

However, the Examiner notes that in the original specification, Applicant discloses that the implementation may be applied to a facsimile machine or **a copier** (emphasis added) (see page 5, paragraph 25 of the original specification), and that data can be data that is **scanned into the printer system** (emphasis added) (see page 7, paragraph 29). This is exactly what is disclosed by *Tabata* – a copier (470) comprising an integrated scanner and printer (column 25, lines 4-8) that detects an address in a data stream. The Examiner continues to read this combination scanner/printer or copier as a printer

Tabata discloses a copier (470) that receives print data from a data source (medium form) (420) obtains a URL or address information from the data, retrieves data pertaining to the URL from a network source and incorporates that retrieved information (a correlated information file) into the medium form (column 23, line 13 to column 24, line 49). It is unclear to the Examiner how this disclosure teaches away from the claimed invention especially since on page 7, paragraph 0029 of the original specification, Applicant discloses that the data could be “**scanned into the printer system**”, as does *Tabata*.

Applicant submits that “it therefore appears that the position which is being taken [by the Examiner] for the sake of rejection is that – if the copier reads the information then the “printer” reads the information.” This submission is an erroneous characterization of the position of the Examiner. The printer as claimed is clearly being read as the integrated printer/scanner, with the address being detected by the scanner portion of the copier. It is unclear to the Examiner how this would differ from Applicant’s copier implementation the instant application.

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Applicant also submits that the printers in *Tabata* are not equipped with anything that would allow a message to be sent therefrom. Again the Examiner disagrees.

Tabata discloses that the integrated scanner and printer are connected to the network terminal with a serial or parallel cable (column 27, lines 26-33). This clearly indicates that there is bidirectional communication between the copier and terminal.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

A handwritten signature in black ink, appearing to read 'Mark E. Wallerson', with a stylized, cursive script.

MARK WALLERSON
PRIMARY EXAMINER